

## **REMARKS/ARGUMENTS**

Claims 61-65, 68-70 and 74-74 are pending in this application. Claims 63-65 and 68 are allowed.

Applicants acknowledge the withdrawal of the written description rejection under 35 U.S.C. §112, first paragraph, and the rejections under 35 U.S.C. §102 and §103 over Struyk *et al.* The remaining rejection under 35 U.S.C. §112, second paragraph, and the new rejection under 35 U.S.C. §102 over Fukushima *et al.* are addressed below.

### **I. Claim Rejections Under 35 U.S.C. § 112, Second Paragraph**

Claims 61-62, 69-70 and 74-75 remain rejected under 35 U.S.C. § 112, second paragraph, as allegedly “being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.” In particular, the Examiner has asserted that the recitation of “An isolated polypeptide ... comprising a polypeptide” is indefinite because allegedly “it is unclear whether the claims are drawn to a polypeptide comprising the recited amino acid sequences or if the claims are drawn to a fusion polypeptide comprising at least two polypeptides wherein one of the polypeptides comprises a polypeptide having the recited amino acid sequences.” (Page 9 of the Office Action mailed November 23, 2005).

Applicants respectfully submit that the language of the claims clearly indicates that the claims are drawn to a polypeptide comprising the recited amino acid sequences. It is well understood in the art and in patent law that a polypeptide “comprising” recited amino acid sequences may also include additional amino acid sequences. A fusion polypeptide wherein one of the polypeptides comprises a polypeptide having the recited amino acid sequences is merely a subset of the claimed polypeptides comprising the recited amino acid sequences. Thus the metes and bounds of the claims would be clear to one of ordinary skill in the art.

Accordingly, Applicants respectfully request that the rejection of Claims 61-62, 69-70 and 74-75 under 35 U.S.C. §112, second paragraph, be withdrawn.

### **II. Priority**

The Examiner has granted Claims 63-65, 68 and 74-75 a priority date of March 8, 1999 based upon the disclosure of the proliferation of rat utricular supporting cells assay in PCT/US99/05028. The Examiner has granted Claims 61-62 and 69-70 a priority date of

February 18, 2000 based upon the disclosure of the chondrocyte re-differentiation assay in PCT/US99/04341.

Applicants respectfully point out that Claims 69 and 70 depend upon both Claim 61 and Claim 74; thus insofar as Claims 69 and 70 depend upon Claim 74, they are entitled to the priority date of March 8, 1999.

Applicants further note that the instant application also claims priority to U.S. Provisional Application Serial No. 60/079,294 filed on March 25, 1998. As discussed below, U.S. Provisional Application Serial No. 60/079,294 provides the nucleic acid and amino acid sequences of the PRO337 polypeptide, and discloses that the full length PRO337 polypeptide (SEQ ID NO:523) has significant homology to rat neurotrimin.

### **III. Claim Rejections Under 35 U.S.C. §102**

Claims 61-62 and 69-70 are newly rejected under 35 U.S.C. §102(a) as allegedly being anticipated by Fukushima *et al.* (WO 00/58668, published November 18, 1999). Fukushima *et al.* teach an isolated polypeptide, SEQ ID NO:3, that is identical to SEQ ID NO:523.

Applicants respectfully submit that, as evidenced by U.S. Provisional Application No. 60/079,294, filed March 25, 1998 (Exhibit A), Applicants had cloned and sequenced SEQ ID NO:522, and determined the homology of the encoded polypeptide (SEQ ID NO:523) to rat neurotrimin, before the prior art date of November 18, 1999.

### **Applicants Need to Disclose Only What is Disclosed in the Cited Reference to Support the Priority Claim**

Applicants respectfully submit that in order to overcome the 35 U.S.C. §102(a) rejection over Fukushima *et al.*, Applicants simply needs to provide a disclosure commensurate in scope with the disclosure in the prior art document by Holtzman *et al.* to support the priority claim.

In order to remove a reference as a prior art, “[i]t is sufficient if [patentee] shows that as much of the claimed invention as is taught in the reference has been reduced to practice by the [patentee] prior to the date of the reference.” *In re Stempel*, 241 F.2d 755, 757 (1957). In *In re Stempel*, the patent applicant (Stempel) had claims directed to both (i) a particular genus of chemical compounds (the “generic” claim) and (ii) a single species of chemical compound that was encompassed within that genus (the “species” claim). In support of a rejection under 35 U.S.C. §102, the examiner cited against the application a prior art reference that disclosed the

exact chemical compound recited in the “species” claim. In response to the rejection, the patent applicant filed a declaration under 37 C.F.R. §1.131 demonstrating that he had made that specific chemical compound prior to the effective date of the cited prior art reference. The Court found the applicant’s 37 C.F.R. §1.131 declaration effective for swearing behind the cited reference for purposes of both the “species” claim and the “genus” claim. Specifically, the Court stated in support of its decision that “all the applicant can be required to show is priority with respect to so much of the claimed invention as the reference happens to show. When he has done that he has disposed of the reference.” *Id.* at 759.

Furthermore, the Examiner is respectfully directed to *In re Moore*, 170 USPQ 260 (CCPA 1971), where the holding in *In re Stempel* was affirmed. In *In re Moore*, the patent applicant claimed a particular chemical compound in his patent application and the examiner cited against the applicant a prior art reference under 35 U.S.C. §102 rejection which disclosed the compound but did not disclose any specific utility for the compound. The patent applicant filed a declaration under 37 C.F.R. §1.131 demonstrating that he had made the claimed compound before the effective date of the cited prior art reference, even though he had not yet established a utility for that compound. On appeal, the Court indicated that the 131 declaration filed by the patent applicant was sufficient to remove the cited reference. The Court relied on the established “Stempel Doctrine” to support its decision, stating:

An applicant need **not** be required to show any more acts with regard to the subject matter claimed that can be carried out by one of ordinary skill in the pertinent art following the description contained in the reference ... the determination of a practical utility when one is not obvious need **not** have been accomplished prior to the date of a reference unless the reference also teaches how to use the compound it describes.

*In re Moore*, 170 USPQ at 267 (emphasis added).

Thus, *In re Moore* confirmed the holding in *In re Stempel* which states that in order to effectively remove a cited reference as prior art, **an applicant need only show that portion of his or her claimed invention that appears in the cited reference.**

As the Examiner noted, Fukushima *et al.* discloses a nucleic acid encoding a polypeptide (SEQ ID NO:3) that is 100% identical to SEQ ID NO:523. Fukushima *et al.* discloses that SEQ ID NO:3 shows significant homology to rat neurotrimin. Although Holtzman *et al.* includes

general statements regarding possible uses of the sequence, no specific examples or experimental data are provided regarding the use of SEQ ID NO:3.

Applicants respectfully submit that since Fukushima *et al.* only disclose a polypeptide sequence, its encoding nucleic acid sequence, and a sequence homology, without any disclosure to support utility, Applicants simply need to show possession of the polypeptide sequence and its encoding polynucleotide sequence as well as a sequence homology, as disclosed in Fukushima *et al.*, in order to remove the reference as prior art under 35 U.S.C. §102.

Applicants respectfully submit that U.S. Provisional Application Serial No. 60/079,294 filed on March 25, 1998, provides the nucleic acid and amino acid sequences of the PRO337 polypeptide.

U.S. Provisional Application Serial No. 60/079,294 filed on March 25, 1998 discloses sequences designated as SEQ ID NO:1 and SEQ ID NO:2, (see Figures 1 and 2) which are identical to SEQ ID NO:522 and SEQ ID NO:523, respectively, of the above-identified application. U.S. Provisional Application Serial No. 60/079,294 further discloses that the full length PRO337 polypeptide (SEQ ID NO:523) has significant homology to rat neurotrimin (see Example 2).

Accordingly, Applicants respectfully submit that the disclosures are commensurate in scope and that U.S. Provisional Application Serial No. 60/079,294 discloses all that the cited prior art discloses.

Consequently, based on the holdings of *In re Stempel* and *In re Moore*, Fukushima *et al.* is not prior art under §102 since its effective priority date is after the invention by the Applicants for patent, as demonstrated by the filing U.S. Provisional Application Serial No. 60/079,294 on March 25, 1998.

Accordingly, withdrawal of the rejection of Claims 61-62 and 69-70 under 35 U.S.C. §102(a) as anticipated by Fukushima *et al.* is respectfully requested.

### CONCLUSION

In conclusion, the present application is believed to be in *prima facie* condition for allowance, and an early action to that effect is respectfully solicited. Should there be any further issues outstanding, the Examiner is invited to contact the undersigned attorney at the telephone number shown below.

Please charge any additional fees, including fees for additional extension of time, or credit overpayment to Deposit Account No. 08-1641 (referencing Attorney's Docket No. 39780-2630 P1C12).

Respectfully submitted,

Date: August 3, 2006

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